

REMARKS/ARGUMENTS

Claims 7-18 are pending. No claim is added, amended, or canceled.

Claims 7-11 and 13-18 stand rejected under 35. U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,350,553 ("the Glaser patent") in view of either PCT Patent Application No. WO 96/20252 ("the Schubert application") or Japanese Patent Application No. 05105805 ("the Kamata application"). As is well known, an invention is not obvious under the patent laws simply because it is theoretically possible-- with the aid of hindsight-- to combine references in a manner that might yield a claimed invention. The prior art itself must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In arriving at the conclusion that the cited art should be combined, the Office relies on a statement in the Glaser patent that any suitable injection molding adhesive can be used (pages 2-3 of the Office Action; column 3, lines 40-44 of the Glaser patent). There is no guidance to select the adhesives used in the Schubert application and the Kamata application for use in the Glaser patent. At most, the disclosure of the Glaser patent is an invitation to experiment and provides no guidance in selection of an adhesive. Thus, nothing in the Glaser patent suggests the combination with the Schubert application or the Kamata application.

Moreover, nothing in the Schubert application or the Kamata application suggests a combination with the Glaser patent. The Schubert application's teachings concerning the use of an adhesive to encapsulate electronic circuits is one of many possible uses described for this application. Certain processes do not contain an insert (see, for example, column 8, lines 35-39). When inserts are used, electric circuits are but one of the materials listed. Other uses include encapsulation of cables, wires, filaments, switches, sensors, connectors, and the like (see, for example, column 8, lines 39-58). In fact, the only example in the Schubert application is directed to a PVC cable (see column 8, line 61 to column 9, line 38). Thus, the Glaser patent has no preference for an adhesive of the Schubert application and the Schubert application does not have a preference for a process of the Glaser patent. Only when presented with the Applicant's blueprint would one skilled in the art be motivated to make the combination put forth in the Office Action.

Likewise the Kamata application does not suggest a combination with the Glaser patent. The Kamata application is not directed to the chip cards of the Glaser patent. That electronic parts can be encapsulated by the adhesive in the Kamata application is not enough motivation to compel the use of such adhesives in the process of the Glaser patent. Electronic components vary widely in nature. Absent Applicant's blueprint, there is insufficient motivation to combine the cited art. Where, as here, neither reference suggest employment of the other, a rejection cannot be maintained. As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 7-10 and 12-18 stand rejected as allegedly obvious over European Patent Application No. 649719 ("the Goetzendorfer application") in view of either the Schubert application or the Kamata application. Like the Glaser application, the Goetzendorfer application neither discloses or suggests the adhesive of the instant claims. For reasons completely analogous to those discussed for the rejection based on the Glaser patent, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 7-10 and 12-18 stand rejected as allegedly obvious over Japanese Patent Application No. 09240179 ("the Tagami application") in view of either the Schubert application or the Kamata application. Like the Glaser patent and the Goetzendorfer application, the Tagami application neither discloses or suggests the adhesive of the instant claims. The arguments presented against the rejections based on the Glaser patent and the Goetzendorfer application apply equally to this rejection. As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

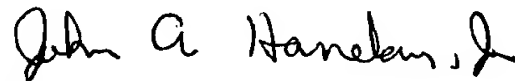
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Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

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